REMARKS/ARGUMENTS

This Amendment and the following remarks are intended to fully respond to the Office Action mailed June 6, 2006. In that Office Action claims 1-41 were examined, and all claims were rejected. More specifically, claims 1, 2, 5, 9, 12, 15, 17, 19 and 20 were rejected under 35 U.S.C. § 102(e) as being anticipated by Shen (USPN 6,611,850); claims 1, 2, 4, 5, 7, 9, 12-15, 17, 19 and 20 were rejected under 35 U.S.C. § 102(e) as being anticipated by Bly et al. (USPN 5,008,853). Additionally, claims 3, 4, 6-8, 10, 11, 16, 18, and 21-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Shen and Bly in combination with one or more of U.S. Patent Nos. 5,832,508 to Sherman; 6,088,694 to Burns; 6,622,164 to Harrison; 6,112,024 to Almond; 6,598,059 to Vasudevan et al.; 5,873,103 to Trede et al.; 6,610,105 to Martin, Jr. et al.; 6,571,245 to Huang et al.; 5,787,411 to Groff et al.; 6,510,552 to Benayoun; 5,634,052 to Morris; 4,503,499 to Mason; 6,212,512 to Barney et al.; and U.S. Pat. Publication No. 2002/0129047 to Cane et al.

In this Response, claims 1, 6, 13, and 32 have been amended; and claims 5, 12, and 21-30 have been canceled. New claims 42-46 have been added. Reconsideration of the Examiner's rejections, as they might apply to the original and amended claims in view of the foregoing amendments and following remarks, is respectfully requested.

Newly Added Claims

Applicants have added new claims 42-46 for the purposes of expediting the allowance of subject matter in the present application. Applicants believe that claims 42-46 are patentable over the references cited by the Examiner. The specific reasons for this conclusion are discussed in detail below.

Claim Rejections – 35 U.S. C. § 102

Claims 1, 2, 5, 9, 12, 15, 17, 19 and 20 were rejected under 35 U.S.C. § 102(e) as being anticipated by Shen (USPN 6,611,850). Additionally, claims 1, 2, 4, 5, 7, 9, 12-15, 17, 19 and 20 were rejected under 35 U.S.C. § 102(e) as being anticipated by Bly et al. (USPN 5,008,853).

As previously described, embodiments of the present invention provide for allowing a client to request prior versions of files that may be stored on a remote server. In response to a user request for a list of prior versions of a file, a list of available shadow volumes (point-in-time copies of a volume) that may contain prior versions of the file are obtained. Information such as timestamps corresponding to the shadow volumes are obtained as part of the list. The list can then be used by a client to request a specific prior version of a file that is within one of the shadow volumes. A client may send a request that includes timestamp information to open the specific prior version of the file. None of the references cited by the Examiner teach or suggest the combination of elements recited in the claims, including retrieving information such as timestamps that correspond to available shadow volumes.

The newly cited Shen reference describes a backup/restore method for generating backup copies of files and restoring original files from the back up copies. The method described by Shen includes a backup copy generating process where a random file stored in a first storage device is copied to a second storage device to make a backup copy. A restore process uses a back up copy from the storage device to restore an existing file or a non-existing file in the first storage device. Shen also describes a restore detail instructing process where a target file and a time period (measured back from the current time) are designated to execute the restore process to restore one or more files to a state of the designated time period. Shen does not however disclose retrieving information regarding available shadow volumes in response to a client request.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. MPEP § 2131 (*quoting Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). The identical invention must be shown in as complete detail as is contained in the claim. MPEP § 2131 (*quoting Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). Not withstanding the Examiner's assertions, both Shen and Bly fail to meet the legal standard for anticipating the currently pending claims.

Applicants first note that claims 1, 32, and 42 require returning or obtaining timestamps corresponding to ***shadow volumes***. As the term shadow volumes is used in the present

application, it does not mean the same thing as files. Rather, a shadow volume is a point in time copy of a volume of memory. *See Detailed Description*, page 26, lines 15-22. The shadow volume may or may not contain prior versions of selected files that a user requests. As stated on page 31 of the Detailed Description:

> [n]ot all shadow volumes will necessarily have a copy of the file, e.g., a file may have been initially created after an existing shadow volume was captured, or the file could have been deleted prior to a given capture, whereby that existing shadow volume will not have a version of that file.

As this quoted language makes clear, a shadow volume cannot be equated with a mere copy of a file.

Turning now to the Examiner's rejections, the Examiner points to a variety of portions in both Shen and Bly that disclose timestamps. Applicants submit that none of these timestamps are associated with a shadow volume, i.e. a point-in-time copy of a ***volume***. For example, the Examiner asserts that Shen discloses timestamps corresponding to shadow volumes at col. 19, lines 45-67 and col. 20, lines 1-5. *See Office Action* (June 6, 2006), page 6. However, Shen describes that the timestamps are associated with "files" and not "shadow volumes." Specifically, Shen states:

> The restore information setting unit 212 will, from the generation management table already read in, search for the backup file of designated file ("thisfile.doc") at designated time (1 month ago). Specifically, it will look into the 1 month column of FIG. 7(c), and select ***the file*** 'thisfile.doc.1997.07.01.15.30' as the backup copy.
>
> Then the restore information setting unit 212 will request the restore execution to backup/restore execution control unit 214 by passing the restore target full path file name c\mydoc\thisfile.doc and ***the file to be used for this restoration*** d\backup\mudoc\thisfile.doc.1997.07.01.15. 30.'

Shen at col. 19, lines 57-67.

With respect to Bly, the Examiner asserts that Figs. 3 and 4 of Bly disclose timestamps associated with shadow volumes. *See Office Action* (June 6, 2006), page 9. Applicants respectfully disagree. Figs. 3 and 4 are property sheets for data objects. Data objects are not shadow volumes. Bly describes examples of structured data objects as including: "(1) A multi-

page document wherein each page is a data object linked to both preceding and subsequent pages, which are data objects, in a predetermined order (2) A workspace or desktop, as defined by the display screen per se which contains multiple structured data objects, e.g., file folders or documents, which, in turn, may contain other structured data objects. For example, a file folder may contain several documents, other file folders or a file drawer." *Bly at col. 2 lines 5-13.* Thus, the timestamps in Bly cited by the Examiner are not associated with shadow volumes.

Applicants respectfully submit that copies of files and shadow volumes are two distinct concepts, and as described above, neither Shen nor Bly teach or suggest returning or obtaining timestamps associated with shadow volumes. For at least this reason, each of the independent claims 1, 32, and 42 are novel over the disclosures of Shen and Bly.

Additionally, claim 42 requires that a client send a subsequent request to a server for a specific prior version of a file. The request sent by the client includes one of the timestamps previously returned by the server. Following receipt of the subsequent request, a specific prior version of the file is opened. Neither Bly nor Shen disclose these additional limitations of claim 42, and for at least these additional reasons, claim 42 is patentable over both Bly and Shen.

Claims 2-4, 6-11, 13-20, 33-41; and 43-46 depend upon one of claims 1, 32, and 42; and are allowable for at least the same reasons. In addition, each of these claims recite additional limitations that further distinguish over Shen and Bly.

Claim Rejections – 35 U.S.C. § 103

Claims 3, 4, 6-8, 10, 11, 16, 18, and 21-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Shen and Bly in combination with one or more of U.S. Patent Nos. 5,832,508 to Sherman; 6,088,694 to Burns; 6,622,164 to Harrison; 6,112,024 to Almond; 6,598,059 to Vasudevan et al.; 5,873,103 to Trede et al.; 6,610,105 to Martin, Jr. et al.; 6,571,245 to Huang et al.; 5,787,411 to Groff et al.; 6,510,552 to Benayoun; 5,634,052 to Morris; 4,503,499 to Mason; 6,212,512 to Barney et al.; and U.S. Pat. Publication No. 2002/0129047 to Cane et al.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Manual of Patent Examining Procedure* (MPEP) § 706.02(j) (*citing In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). The Applicants respectfully submit that the Examiner has not met the burden of establishing a *prima facie* case of obviousness, because the combination of references cited by the Examiner fail to disclose all the elements of the claims.

As described above, neither Shen nor Bly disclose returning or obtaining timestamps associated with shadow volumes, in combination with the other limitations of claims 1, 32, and 42. None of the other references cited by the Examiner compensate for the deficiency in Shen and Bly. For at least this reason, the Examiner has not established a prima facie case of obviousness with respect to claims 3, 4, 6-8, 10, 11, 16, 18, and 21-41 as they depend upon one of claims 1 or 32.

Conclusion

This Amendment fully responds to the Office Action mailed on June 6, 2006. Still, the Office Action may contain arguments and rejections that are not directly addressed by this Amendment because they are rendered moot in light of the preceding arguments in favor of patentability. Hence, failure of this Amendment to directly address an argument raised in the Office Action should not be taken as an indication that the Applicant believes the argument has merit. Additionally, failure to address statements/comments made by the Examiner does not mean that the Applicants acquiesce to such statements or comments. Furthermore, the claims of the present application may include other elements, not discussed in this Amendment, which are not shown, taught, or otherwise suggested by the art of record. Accordingly, the preceding arguments in favor of patentability are advanced without prejudice to other bases of patentability.

It is believed that no fees are due with this Response. However, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment with respect to this patent application to deposit account number 13-2725.

In light of the above remarks and amendments, it is believed that the application is now in condition for allowance and such action is respectfully requested. Should any additional issues need to be resolved, the Examiner is requested to telephone the undersigned to attempt to resolve those issues.

Respectfully submitted,

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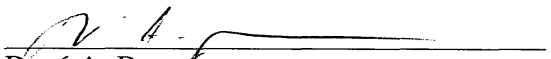

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